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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,387	01/17/2002	Jian Ling Ding	17644-68	1539
33717	7590	10/04/2006	EXAMINER	
GREENBERG TRAURIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404			GHALI, ISIS A D	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/053,387	DING ET AL.	
	Examiner	Art Unit	
	Isis Ghali	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-8,10,13,16 and 18-38 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5-8,10,13 and 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicants' amendment and request for RCE, both filed 07/11/2006.

Claims 1, 4, 9, 11, 12, 14, 15, 17 have been canceled.

Claims 2, 3, 5-8, 10, 13, 16, 18-38 are pending.

Claims 2, 3, 5-8, 10, 13, 18-31 have been withdrawn from consideration, being drawn to nonelected invention.

Claims 16 and 32-38 are included in the prosecution.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitation "stabilizer" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 32, 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,335,026 ('026).

US '026 disclosed an adhesive composition for application to the skin as an adhesive bandage and tape (col.1, lines 7-11; col.3, lines 50-55). The composition comprises ethylene-propylene-diene monomer terpolymer wherein the ratio of ethylene to propylene is 3:1, i.e. 75% ethylene and 25% propylene (col.2, lines 57-61). The composition comprises up to 20% of silica, which disclosed by applicants as hydrophilic particles (col.4, lines 9-10; col.6, lines 31-32). The composition further comprises polyisobutylene, styrene block copolymer in an amount of 25-42%, elastomer stabilizer, pigments, and anti-oxidants which read on the active agent disclosed by applicants (col.2, lines 20-33, 42-44; col.3, lines 30-33; col.5, lines 27-29; col.5, examples I-III).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '026 in view of US 5,750,134 ('134).

The teachings of US '026 are discussed above. However, US '026 does not expressly teach the butyl rubber as a stabilizer, but recognized the addition of stabilizer to the composition comprising EPDM.

The specific stabilizer claimed by applicant does not impart patentability to the claims, absent evidence to the contrary.

US '134 teaches adhesive composition that is suitable for delivering systemically and locally active agents, wherein the composition comprises elastomeric component such as butyl rubber (abstract; col.3, lines 5-15; col.4, lines 50-65). The elastomeric

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component renders the ultimate composition be worn comfortably by the user and the composition does not exhibit excessive cold flow when stored at room temperature (col.4, lines 42-49).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver the adhesive composition comprising EPDM and elastomer as disclosed by US '026 and replace the stabilizer by the butyl rubber disclosed by US '134, motivated by the teaching of US '134 that the elastomeric component renders the ultimate composition be worn comfortably by the user and the composition does not exhibit excessive cold flow when stored at room temperature, with reasonable expectation of having adhesive composition comprising EPDM and butyl rubber that is worn comfortable by the user that exhibits minimal cold flow.

8. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over US '026 in view of US 6,805,961 (961).

The teachings of US '026 are discussed above. However, US '026 does not expressly teach the composition further comprises ethylene propylene elastomer, but recognized the addition to elastomer to the composition comprising EPDM.

The specific claimed elastomer does not impart patentability to the claims, absent evidence to the contrary.

US '961 teaches an adhesive tape comprising amorphous polyolefin based on propylene that provides improved relaxation properties and flexibility of the tape (col.6, lines 1-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to deliver the adhesive composition comprising EPDM and elastomer as disclosed by US '026 and replace the elastomer by the amorphous propylene based polyolefin disclosed by US '961, motivated by the teaching of US '961 that the amorphous propylene based polyolefin provides improved relaxation properties and flexibility of the tape, with reasonable expectation of having adhesive composition comprising EPDM and amorphous propylene based polyolefin that has improved relaxation properties and flexibility.

Response to Arguments

9. Applicant's arguments filed 07/11/2006 have been fully considered but they are not persuasive. Applicants failed to traverse the rejection over US '026, therefore, the rejection is maintained. Applicants traverse the obviousness rejection of claims 16 over US '134 and claim 33 over US '961 by arguing that the prior art does not teach the combination to achieve better fluid absorption.

In response to this argument, the examiner position is that a conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969). US '134 is relied upon for the solely teaching of the suitability of butyl rubber in compositions applied to the skin. US '134 teaches that such elastomeric component renders the ultimate composition be worn comfortably by the user and the

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composition does not exhibit excessive cold flow when stored at room temperature, and this teaching would have motivated one having ordinary skill in the art to add elastomeric component to adhesive skin composition disclosed by US '026. US '961 is relied upon for the solely teaching of suitability of propylene in skin adhesive compositions. US '961 teaches that the amorphous propylene based polyolefin provides improved relaxation properties and flexibility of the tape, and this teaching would have motivated one skilled in the art to replace the elastomer disclosed by US '026 by amorphous propylene based polyolefin as disclosed by US '961. In the light of the foregoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103 (a), and a *prima facie* case of obviousness has been established.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Isis Ghali
Examiner
Art Unit 1615

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